REMARKS

Claims 1-19, 21-41, and 43-57 are pending, with claims 1, 12, 19, 23, 34, 41, 45, and 56 being independent. Reconsideration and allowance of the above-referenced application are respectfully requested.

Information Disclosure Statements:

Please note that an IDS was filed in this case on October 31, 2003 (with the original application), and another IDS was filed in this case on September 21, 2007. The signed 1449 forms for these two IDS's have not yet been received. Please provide copies of the signed 1449 forms for these two additional IDS's to show that the art cited therein has been considered.

Rejections under 35 U.S.C. §§ 102 & 103:

Claims 1, 4-19, 21-23, 26-41 and 43-57 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,380,120 to Garcia. Claims 2-3 and 24-25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Garcia in view of Official Notices. These rejections are respectfully addressed.

Claim 1 recites, "receiving a request from a client to take an action with respect to a first electronic document, the action unrelated to a second electronic document; and synchronizing offline access information with the client, in response to the request, to pre-authorize the client, to allow actions by a user as a member of a group of users, by sending to the client an update to offline access information retained at the client, the update comprising a first key associated with the group, the first key being useable at the client to access the second electronic document while

offline by decrypting a second key in the second electronic document."[1] As previously argued, Garcia fails to describe this subject matter, where offline access to an electronic document is provided in response to a request to take an action that is unrelated to the electronic document for which offline access is provided, because Garcia does not describe synchronizing offline access information before going offline so that previously created documents (unrelated to the requested action that triggers the synchronization) can still be accessed while offline. In response to this point, the Office states, "Garcia teaches such feature, since before going offline, (Garcia, col.32-33) the user requests offline access authorization which is processed by the server, and includes updating (i.e. synchronize) rules and keys for offline access."[2]

However, the requested actions described here and elsewhere in Garcia are clearly related to the document for which offline access is provided and thus cannot meet the claim requirement that the request be "unrelated to a second electronic document" to which pre-authorized client access is being granted. To address this deficiency of the rejection, the Office further states:[3]

> Garcia teaches providing offline access to a particular document, and then the user can create a document while offline, i.e. second document. Further, the access control to this second document is "unrelated to the electronic document" for which offline access is provided.

This statement misrepresents the actual claim language. It is not the access control to the second document that is "unrelated to the electronic document" for which offline access is provided. Rather, it is the action requested with respect to a first electronic document that is unrelated to the second electronic document for which offline access is provided.

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[1] *See* Claim 1 (emphasis added).
[2] *See* 12/09/09 Office Action at pages 2-3.
[3] *See* 12/09/09 Office Action at page 2.

Furthermore, by switching to referencing an uncreated document as the alleged second document of the claim, the Office has created an inconsistency in the proposed claim interpretation. In particular, the Office now states:[4]

> When the user gets back to the company's premises and synchronizes (transparently), the synchronization applies not only to the files for which off-line access was requested prior to leave the premises, but also to the ones created while off-line (col.3-4).

But this communication clearly represents a synchronization of access information generated while offline (i.e., for a document created while offline) back to a server system. Thus, it cannot be covered by "synchronizing offline access information with the client, in response to the request, to pre-authorize the client", as recited in the claim.

For at least the above reasons, the rejection of independent claim 1 should be withdrawn. Claims 2-11 depend from claim 1 and should thus be allowable over Garcia based on this dependence from claim 1 and the additional recitations they contain. For example, claim 11 recites, "wherein the offline access information update further comprises at least one set of document-permissions information, associated with a specific document, selected based on synchronization prioritization information." The Office rejects this claim with a bare citation to col. 33, lines 1-67 of Garcia.[5] However, this portion of Garcia describes enabling off-line access capability by, in part, placing "a time-sensitive access amendment to the desired secured documents"[6] and says nothing about synchronization prioritization information used to select

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[4] *See* 12/09/09 Office Action at page 2.
[5] *See* 12/09/09 Office Action at page 8.
[6] *See* Garcia at col. 33, lines 10-22.

document-permissions information to update. Thus, there is a clear legal or factual deficiency in the rejection of at least claim 11.

Independent claims 12, 23, 34, 45 and 56 recite features similar to those of claim 1. Thus, for at least the reasons discussed above with regard to claim 1, the rejection of claims 12, 23, 34, 45 and 56 should be withdrawn. Claims 13-18, 24-33, 35-40, 46-55 and 57 depend from claims 12, 23, 34, 45 or 56, and should thus be allowable over Garcia based on this dependence from an allowable base claim and the additional recitations they contain. Accordingly, withdrawal of the rejection of claims 1, 2-18, 23, 24-40, and 45-57 is respectfully requested.

Independent claim 19 recites, among other things, "incorporating into the encrypted electronic document an address of a document control server, document-permissions information, and an encryption key useable in decrypting the encrypted electronic document, the encryption key being encrypted with a key generated by, and associated with a group of users of, the document control server." The Office has apparently admitted that Garcia fails to disclose these claimed features, stating, "adding an address (claim 19) to the myriad of items already taught by Garcia would have been obvious, and Examiner submits that it the address is inherent to the system, in order for the client to know to which server it needs to communicate, transparently."[7]

As previously noted, the Office's assertion of inherency is reason to have a server address stored somewhere, not in the document in particular, and the Office has no basis for asserting that incorporating an address of a document control server into an encrypted electronic document

[7] *See* 05-14-2009 Office Action at page 2 and 12-09-2009 Office Action at page 3.

is somehow inherent to the disclosure of Garcia. In response to these points, the Office now states:[8]

> since somehow the client and the server communicate securely, an address is needed, and computer systems inherently posses an identifier or address when connected to a network. Furthermore, Garcia teaches an encrypted portion of a header including the access control rules, which Examiner interprets as inherently including the control server address in order to synchronize when connected.

However, the fact that an address is needed in the network communications has no bearing on whether or not an address is incorporated into an encrypted electronic document, since this document is a payload to such communications and the address can necessarily be stored by the programs performing the communications. Moreover, no evidence has been provided for the interpretation that the access control rules inherently include the control server address.

For at least the above reasons, the rejection of independent claim 19 should be withdrawn. In addition, in apparent recognition of the deficiency of the rejection, the Office now also states:[9]

> Even assuming arguendo none of this is "reasonable", Houston (20040030702) literally teaches such feature, a document includes the address of the server.

It should be noted that the addition of Houston was not necessitated by an amendment or based on information submitted in an information disclosure statement. Thus, if this is a new ground of rejection under 35 U.S.C. § 103, the finality of the current Office Action must be withdrawn.[10]

Claims 21 and 22 depend from claim 19 and should thus be allowable over Garcia based on this dependence from claim 19 and the additional recitations they contain. Independent claim

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[8] *See* 12-09-2009 Office Action at page 3.
[9] *See* 12-09-2009 Office Action at page 3.
[10] *See* MPEP 706.07(a).

41 recites features similar to those of claim 19. Thus, for at least the reasons discussed above with regard to claim 19, the rejection of claim 41 should be withdrawn. Claims 43 and 44 depend from claim 41 and should thus be allowable over Garcia based on this dependence from claim 41 and the additional recitations they contain. Accordingly, withdrawal of the rejection of claims 19, 21, 22, 41, 43 and 44 is respectfully requested.

Conclusion

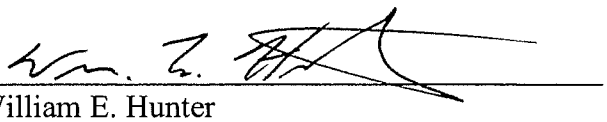
The foregoing comments made with respect to the positions taken by the Office are not to be construed as acquiescence with other positions of the Office that have not been explicitly contested. Accordingly, the arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

All of the pending claims are now in condition for allowance, and a formal notice of allowance is respectfully requested. Absent this, a telephone interview is requested to discuss the independent claims and the cited art.

Please apply any necessary charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Feb. 9, 2010



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